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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,364	12/28/2001	Kaoru Kagami	Q67895	3368

7590

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EXAMINER

PETKOVSEK, DANIEL J

ART UNIT

PAPER NUMBER

2874

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/028,364

Applicant(s)

KAGAMI ET AL.

Examiner

Daniel J Petkovsek

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 5 and 6 is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 4 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: *See Heaf*

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 7 and 8 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Allowable Subject Matter***

2. Claims 2, 5, and 6 are allowed. The most relevant prior art (Zheng U.S.P. No. 6,282,339) does not disclose or reasonably suggest the rod lens to filter adhesive connection to include a convexly shaped connector adhesively connecting the optical elements. Zheng U.S.P. No. 6,282,339 teaches (Fig 2B, columns 4 line 43 through column 5 line 64) an optical filter module 100 comprising the following: a selective optical filter 105; a first optical system including fibers 140 and 145, and a first lens 110 optically connected to filter 105; a second optical system including fiber 185, and a second lens 160 optically connected to filter 105; and a lens surface bonded to a filter by an adhesive agent coated on a portion apart from the optical pathway (Abs. lines 3-7). Zheng U.S.P. No. 6,282,339, or any other related prior art, does not explicitly disclose the system comprising a convex shape or convex surface for adjoining the two optical components.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1, 3, and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. U.S.P. No. 6,282,339 to Zheng discloses each and every

limitation of the claimed invention until the last paragraph, "said at least any one of said lens surface and said filter surface, being opposed each other, has a groove portion which enables the adhesive agent penetrated through the bonded surfaces to stay therein, said groove portion being formed in such a way that penetration of the adhesive agent into the optical path can be blocked." This limitation of the claim does not go into the structure or shape of the groove, but simply claims a groove portion. The groove shape is an important limitation which would facilitate the penetration of the adhesive since any groove shape would not facilitate the adhesive flow. This limitation is thus a statement of a desired result. More structural detail of the groove is needed in claims 1, 3, and 4 to portray the invention more clearly.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 2(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Zheng U.S.P. No. 6,282,339.

Zheng U.S.P. No. 6,282,339 teaches (Fig 2B, columns 4 line 43 through column 5 line 64) an optical filter module 100 comprising the following: a selective optical filter 105; a first optical system including fibers 140 and 145, and a first lens 110 optically connected to filter 105;

a second optical system including fiber 185, and a second lens 160 optically connected to filter 105; and a lens surface bonded to a filter by an adhesive agent coated on a portion apart from the optical pathway (Abs. lines 3-7). Zheng '339 would inherently include a "groove" portion in between the lens and filter surface for containing the adhesive agent.

### *Inventorship*

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, with regards to the state of the art of optical filtering device with filters attached to lens components: References A,B, and D-H (attached PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J Petkovsek whose telephone number is (703) 305-6919. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (703) 308-4819. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9321.



Daniel Petkovsek  
November 13, 2002

